

Application No.: 10/645,523
Art Unit: 3721

Attorney Docket No. 19155.01
Confirmation No. 8121

REMARKS

By the present amendment, Applicant has amended Claims 1, 7-14, 16, 18 and 19, and canceled Claims 2-5. Claims 1 and 6-20 remain pending in the present application. Claims 1 and 19 are independent claims.

In the recent Office Action the Examiner rejected Claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 1-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin (U.S. Patent No. 5,863,100) in view of Millette (U.S. Patent No. 4,821,357). Claims 4 and 5 were further rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Millette, and further in view of Powers (U.S. Patent No. 5,251,371). Claims 19-20 were indicated by the Examiner as being allowable if amended to overcome the rejection under 35 USC 112, second paragraph, and Claims 6-18 were indicated as being allowable if rewritten in independent form.

Regarding the Examiner's rejection of Claim 19 as being indefinite, Applicant has amended the instant claim to delete the language specifically criticized of record. The Examiner's indication of allowable subject matter is noted with appreciation. However, for the reasons delineated herein, Applicant believes that he should be entitled to the scope of protection afforded by claims as presently amended. Regarding the grounds of rejection based on prior art, Applicant will advance arguments hereinbelow to illustrate the manner in which the invention defined by the amended claims is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

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The claims have been amended to more particularly define the subject matter in question and provide express antecedent basis for the claim language. Specifically, amended independent Claim 1 defines a nail gun attachment for installation of roof shingles that includes a lifting blade, a pair of vertically oriented brackets, an adaptor and means for securing the brackets to the adaptor. The lifting blade is set forth as having a front surface and a corresponding rear surface defining a planar top portion, a center portion and a curved lower portion extending downward from and forward of the center portion, with the curved lower portion including side edges that taper to form a beveled front end. The brackets is defined as being attached to the rear surface of the lifting blade at the center portion, and defining a first pair of horizontally aligned bores. The claimed adaptor is characterized as having an attachment plate for removable attachment to a nail gun and a pair of side walls perpendicularly extending from the attachment plate and defining a second pair of horizontally aligned bores. The functional features of the claimed attachment is set forth by the "whereby" clause which states that "when said adapter is secured to said brackets and the nail gun, and upon insertion of the curved lower portion of said lifting blade beneath an adjacent installed shingle and pushing forward on the nail gun, the installed shingle is lifted such that an uninstalled shingle may be placed under the adjacent shingle and nailed in place by the operation of the nail gun." Dependent Claims 7-14, 16 and 18 have been amended in the interest of clarity. Care has been exercised to ensure that no new matter be introduced by the present revisions to the claims.

Applicant contends that none of the references relied upon of record, taken alone or in combination, disclose or reasonably suggest a nail gun attachment having the combination of structural and

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functional features defined by the present claims.

In contrast, the patent to Martin discloses a pneumatic roofing apparatus comprising a housing having a pair of wheels, a planar cutting blade disposed within the housing and an arcuate shovel secured to the front end of the housing over the cutting blade. The upper and lower end of the shovel have the same width and is curved in order to roll old roofing material forward as it is being dislodged by the cutting blade. There appears no mention or suggestion in Martin of Applicant's lifting blade with the attached brackets and adaptor as set forth by the present claims. Clearly, Martin's roofing material removing apparatus is structurally and operationally distinguishable from Applicant's presently claimed attachment device for installing roofing shingles. In an attempt to supplement the apparent deficiencies of the primary reference to Martin, the Examiner relies upon the secondary references to Millette and Powers.

Applicant first notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3rd 994, 50 USPQ2d 1614 (Fed. Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be

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combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

In this regard, Applicant notes that the patent to Millette discloses a structurally unrelated adapter for a power-operated rotary tool, and the Powers patent is directed to a pneumatic nailer for positioning and nailing T-lock shingles, wherein a T-lock spoon member is directly attached to the nail discharge shoe of the nailer. Applicant content that one skilled in the art would not be motivated to combine these non-analogous references in the manner suggested by the Examiner. Applicant further contends that even if the references were properly combinable, the above noted deficiencies of the primary reference to Martin are not remedied by the teachings afforded by the secondary references. Thus, one of ordinary skill in the art without the benefit of Applicant's own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims.. For at least these reasons, Applicant respectfully submits that independent Claim 1, as amended, and corresponding dependent Claims 6-18, as well as Claims 19-20, are allowable over the prior art of record.

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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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